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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,442	11/05/2003	Yasuhito Soma	HYAE:095D	6393

6160 7590 06/17/2005
PARKHURST & WENDEL, L.L.P.
1421 PRINCE STREET
SUITE 210
ALEXANDRIA, VA 22314-2805

EXAMINER

HUBER, PAUL W

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/700,442	Applicant(s) SOMA ET AL.	
	Examiner Paul Huber	Art Unit 2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/492,269.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>110503</u> . | 6) <input type="checkbox"/> Other: ____. |

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The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, claim 10 recites that the "spot position signal detection means and the tracking error detection means are separated from the semiconductor integrated circuit device and is contained in another semiconductor integrated circuit device." However, this subject matter was not described in the specification, particularly figure 16, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The spot position signal detection means 110 and the tracking error detection means 108 are not disclosed in the figure or elsewhere within the specification as being "separated" from the semiconductor integrated circuit device to be contained in another semiconductor integrated circuit device as claimed. Note: the semiconductor integrated circuit device claimed in independent claim 9 "comprises" first control means 120, second control means 114, and system operation control means 116, as well as the spot position detection means 110 and tracking error detection means 108. There is no disclosure that the spot position detection means 110 and tracking error detection means 108 are separated from these other elements and contained in another semiconductor integrated circuit as claimed. This is a new matter rejection pertaining to claim 10.

Claim 9 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 6,473,373. Although the conflicting claims are not identical, they are not patentably distinct from each other because as noted by the Federal Circuit in *Eli Lilly v. Barr*, "[a] patentable distinction does not lie where a later claim is anticipated by an earlier one." See also *In re Berg* and *In re Goodman* which established that a later genus claim limitation is anticipated by, and therefore not patentably distinct from, an earlier species claim.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van*

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Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

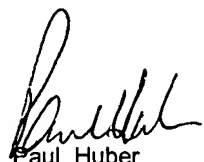
Claim 9 would be allowable if a terminal disclaimer is timely filed as explained above.

The following is an examiner's statement of reasons for allowance: the prior art of record considered as a whole fails to teach or suggest a semiconductor integrated circuit device used for an optical disc apparatus having converging means for converging a light spot on the surface of an optical disc, an optical head which has first moving means for moving the light spot, which is applied to the surface of an optical disc, radially across the surface of an optical disc, and second moving means for moving the optical head radially across the surface of the optical disc, for recording or reproducing information, comprising: spot position detection means for generating a spot position signal which indicates a positional difference in a radial direction of the optical disc, between a center of the optical head and the light spot on a receiving element on the optical head, from an electrical signal outputted by the optical head; tracking error detection means for generating a tracking error signal which indicates a positional dislocation between the light spot and a track on an optical disc; first control means for causing a phase compensation loop filter to filter the spot position signal or the tracking error signal to generate a first processed signal and outputting the first processed signal to the first moving means; second control means for causing a traverse loop filter to filter the spot position signal to generate a second processed signal and outputting the second processed signal to the second moving means; and **system operation control means for operating the first control means to cause the phase compensation loop filter to filter the spot position signal, the filtering being a phase-lag compensation and a phase-lead compensation filtering, the system operation control means for switching from the spot position signal to the tracking error signal to cause the phase compensation loop filter to filter the tracking error signal, the filtering being a phase-lag compensation and a phase-lead compensation filtering, and operating the second control means after operating the first control means.** (bold language emphasized)

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.

A handwritten signature in black ink, appearing to read 'Paul Huber', is positioned above the printed name.

Paul Huber
Primary Examiner
Art Unit 2653

pwh
June 7, 2005